

REMARKS

Reconsideration of this application is respectfully requested. Applicant has addressed every ground for rejection in the Office Action dated September 30, 2004, Paper No. 09282004, and believes the application is now in condition for allowance.

The present invention relates to a poker game and method for playing the same that allows a player to place an initial wager that the final hand will be a winning hand and to place a second wager, after the initial cards are dealt, that the final hand will contain a specific card combination that is of a higher ranking than the initially dealt cards. In particular, the player places an initial wager that the final hand will contain any one of the preselected winning card combinations. Once the bet is placed, an initial hand of cards is dealt to the player. After the cards are dealt, the player may then elect to place a second wager, which is independent from the initial wager, that the final hand will contain a particular combination of cards that is of a higher ranking than the initially dealt cards. For example, if the initial hand comprises one pair, the player may make a proposition bet that the final hand composition will be of a better ranking than one pair (e.g., three of a kind or two pair). If the final hand contains the particular combination of cards that the player bet on, then the player wins both the initial and second wager. However, if the final hand does not match the particular combination of cards, but does match one of the preselected winning card combinations, then the player will win the initial wager, but lose the second wager.

Claims 11 and 12 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. In particular, the Examiner stated that there is insufficient antecedent basis for the use of the limitation "said poker hands" as set forth in the preamble in

Claims 11. Claim 11 has been amended to change “said poker hands” to “possible poker hands” and Claim 12 has been cancelled. Accordingly, it is respectfully submitted that this rejection is traversed.

Claims 11 and 13-17 stand rejected under 35 U.S.C. §102(e) as being anticipated by Yoseloff U.S. Patent No. 6,227,969. Yoseloff teaches a method of playing cards wherein a player may make one or more side bets that the outcome of cards or symbols will match randomly generated match cards. In other words, the side bet wager in Yoseloff is separate and distinct from determining whether the hand matches a predetermined selection of cards.

Claim 15 has been canceled. Claims 11, 13 and 14, among other claims, have been amended to clarify that the proposition bet is a separate and independent bet directed to whether the final hand composition will match a particular one of said preselected combination of cards having an improved ranking compared to the initially dealt cards. It is respectfully submitted that neither Yaseloff, nor any of the other cited references, teach such a proposition bet. Accordingly, it is respectfully submitted that the rejection be withdrawn and the claims be allowed to issue.

Claims 1-10 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,416,407 to Carrico et al. in view of Yoseloff. Claims 12 and 18 stand rejected under 35 U.S.C. §103(a) as being obvious over Yoseloff in view of Carrico et al. The Examiner stated that it would be obvious to combine the teaching of the draw poker game taught in Carrico with the side bet wagers taught in Yoseloff.

The Carrico patent discloses a multi-draw poker game wherein a player places an original wager and is dealt five cards. If the cards represent a winning hand, the player may elect to halt play and collect his winnings, or elect to draw additional cards. After the cards are drawn, the

player may again elect to either halt play or draw additional cards. If the player elects to draw additional cards, then the player must pay an amount equal to the player's original wager plus an amount equal to any potential winnings the player would have won after the first cards were drawn. In other words, the player must give up a potentially winning hand and potential payoff from an initial winning hand to make the additional wager. [See Col. 6, lines 3-6 ("The player is induced to give up the winning hand and potential payout from that winning hand . . . to make the additional wager . . .").] The player wins if the final hand matches any one of the predetermined winning poker hands (other than the initial winning hand).

Claims 2, 4, 7, 9, 12 and 15 have been canceled. Claims 1, 6 and 11 have been amended to clarify that the proposition bet is directed to having a final hand composition that is of a higher ranking (or improved poker hand) than the initially dealt cards, as set forth in original Claims 2, 7 and 12. Claim 18 has been amended to depend from Claim 1.

According to the Examiner, Carrico et al. teaches all of the limitations of the claims except for a proposition bet whose outcome is determined separately from the initial wager. The Examiner also states that Yoseloff teaches the placement of a proposition bet after the cards are initially dealt.

It is respectfully submitted that there is absolutely no teaching in either of the cited patents to suggest placing any separate and independent bets that the outcome of the final hand composition will match one of the preselected combinations of cards that is of a higher ranking than the initially dealt cards, wherein the bets are placed after the initially dealt cards but before the final hand composition. In response to the Examiner's contention that "[i]t would have been obvious at the time the invention was made to have the final hand composition be an improved poker hand in the invention of Yoseloff" on the basis that players can earn more prizes and enjoy

the game more, it is respectfully submitted such a broad statement is unsupported and is, in fact, contradicted by the cited prior art. First, it is respectfully submitted that if the claimed subject matter were so obvious as the Examiner contends, others in the industry would have already done so. However, there is no prior art that shows or teaches the claimed subject matter. Part of the reason for the absence of this teaching in the prior art is that it is counterintuitive to allow bets to be placed on the specific outcome of the hand after cards have been dealt as the player would have a better idea of the outcome of the hand, and thus a better chance of winning the particular bet. Furthermore, it would be counterintuitive to allow players to place a proposition bet on the final hand composition wherein the player will not lose the initial bet.

Second, both Yoseloff and Carrico teach away from combining the two references. As noted by the Examiner, Yoseloff teaches placing side bets that a series of symbols they receive will match a series of randomly generated symbols. Accordingly, the players must simply base their bets on a guess, as they have no actual idea what symbols may be in the series of randomly generated symbols. According to the Examiner, the claimed invention offers a player the opportunity to make an “educated wager” in that he or she will know at least some of the cards that they have prior to making the bet. However, it is respectfully submitted that the Examiner is improperly looking to the teachings of the claimed invention—rather than the prior art—in making her determination of obviousness as there is absolutely no teaching or suggestion of placing proposition bets *after* the cards are dealt, wherein the proposition bet is whether the final hand composition will be of a higher ranking than the initially dealt cards. In fact, Yoseloff states that the side bet wager is preferably done in five card draw *after* the player’s hand has been fixed, otherwise it would “alter the natural play of the underlying game significantly.” [Col. 11, lines 15-18 (emphasis added)]. Accordingly, Yoseloff acknowledges that placing of a

proposition bet during the play of the game (i.e., after the initial hand is dealt) should be avoided as it alters the *natural play* of the game. The side bet in Yoseloff is also unrelated to the ranking of the combination of cards, as claimed.

Carrico also teaches against the use of separate proposition bets as claimed, as it requires the player to *give up any potential winnings of the second hand* if the player elects to draw any additional cards. In the present invention, the placing of a proposition bet does not affect the outcome of the initial bet. On the contrary, in the present invention, the proposition bet is an additional opportunity for a winning bet.

To allow the rejection of claims based on conclusory statements that the invention would be obvious because it would work better, without any explicit motivation or teaching in the references, would allow for the combination of any and all references if the final product, in the end, works or performs better, thereby eviscerating the protection afforded to inventors and their inventions. It is respectfully submitted that such conclusory statements that the claimed subject matter is obvious are, in fact, made in hindsight based on the teaching of the present patent application and are therefore improper. E.g., Al-Site Corp. v. VSI Int'l, Inc., 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999) (*citing W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 312-13 (Fed.Cir.1983)) (“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”); *Winner Int'l Royalty Corp. v. Wang*, 48 U.S.P.Q.2d 1139, 1144 (D.C. D.C. 1998) (“The standard of obviousness is not whether in hindsight, it seems elementary that someone would have combined these certain elements in the prior art to form the invention in question. See e.g., *W.L. Gore & Assoc., Inc. v. Garlock*,

Inc., 721 F.2d 1540, 1551, [220 USPQ 303, 313] (Fed. Cir. 1983). Hindsight is almost always perfect. It is insufficient to prove that at the time of the claimed invention, the separate elements of the device were present in the known art. Rather, there must have been some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine such elements so as to create the same invention.”).

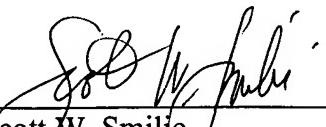
As there is no *explicit* teaching or suggestion of offering separate proposition bets that the final composition of cards will match one or a preselected combination of cards that is of a higher ranking *after* the cards are dealt without the need to forfeit any winnings, and there is no motivation or suggestion in the prior art to combine the references to place a proposition bet after the cards are dealt that the final composition of cards will match a particular one of a plurality of preselected combinations of cards and it will be a higher ranking hand than after the initial cards were dealt and before the proposition bet was made—and the prior art actually teaches against such a combination—it is respectfully submitted that the remaining claims are patentable over the prior art of record. See Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 448-49, 240 USPQ 416 (Fed. Cir. 1986). Accordingly, it is respectfully requested that the present rejection be withdrawn and the claims be allowed to issue.

Should the Examiner discover that there are remaining issues that could be resolved by an interview, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

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